REMARKS

Claims 1-29 were pending in the application at the time the present Office Action was mailed. No claims have been amended, cancelled, or added by this response. Accordingly, claims 1-29 remain pending in the application.

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on November 7, 2003 to discuss the present Office Action. Claims 1-29 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,438,508 to Wyman ("Wyman") in view of applicant's own admission. The following remarks reflect and expand on agreements reached between the undersigned attorney and the Examiner regarding the deficiencies of Wyman with respect to a properly framed Section 103 rejection of the pending claims.

A.   Response to the Section 103 Rejection of Claims 1-29

Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wyman in view of applicant's own admission. A properly framed obviousness rejection requires, *inter alia*, that the combined prior art references teach or suggest all the claimed features. (MPEP 706.02(j); emphasis added.) As discussed in greater detail below, Wyman and applicant's own admission cannot support a properly framed Section 103 rejection of claims 1-29 for at least the reason that these references, either alone or in combination, fail to teach or suggest all the claimed features.

1.   Claim 1 is Directed to a Method of Distributing Software With a Computer System That Includes, *inter alia*, Recording Data on a Fixed Medium in the Computer System, and Recording Authorization to Access the Data in the Computer System

Claim 1 is directed to a method of distributing software with a computer system. The method includes, *inter alia*, recording data on a fixed medium in the computer system, and providing for transfer of the computer system to a user. Access to the data in the computer system is controlled by contacting a party authorized to grant access to the data in response to receiving a first request for access to the data. If the party authorizes access to the data, then the authorization is recorded in the computer

system and access to the data is granted based on the recorded authorization. If the computer system receives additional requests for subsequent access to the data, the computer system grants access to the data based on the authorization previously recorded in the computer system.

Base claim 10 is directed to a software module used in a computer system that controls access to a software application stored on a fixed medium in the computer system. The software module verifies authority to access the software application by, *inter alia*, contacting a party authorized to grant access to the software application. If the party provides authorization to grant access to the software application, the authorization is recorded in the computer system and access is granted based on the recorded authorization. If subsequent access to the software application is detected, subsequent access is granted based on the authorization recorded in the computer system.

Base claim 21 is directed to a computer system operable to provide controlled access to a software application stored on a fixed medium in the computer system. The computer system includes, *inter alia*, a software module that responds to a first activation of the software application by contacting a party authorized to grant access to the software application. If the party provides authorization to grant access to the software application, the software module records the authorization in the memory of the computer system. If subsequent activation of the software application is detected, subsequent access is granted based on the authorization recorded in the memory of the computer system.

2.   Wyman is Directed to a License Management System That Stores Licenses (Product Use Authorizations) on a Remote License Server

Wyman is directed to a license management system that accounts for software product usage in a computer system. In Wyman, the licenses are stored on a server that administers the licenses, and each licensed product upon start-up makes a call to

<u>the license server to determine whether usage is permitted</u>. Quoting from column 6, lines 57-66 of Wyman:

> "[T]he license server maintains a store of the licenses, called product use authorizations, that it administers. Upon receiving a call from the user, the license server checks the product use authorization to determine if the particular use requested is permitted, and, if so, <u>returns a grant to the requesting user node.</u> The license server <u>maintains a database of product use authorizations</u> for the licensed products, and accesses this database for updating and when a request is received from a user."

(emphasis added).

> 3. <u>Wyman and Applicant's Own Admission Cannot Support A Section 103 Rejection of Claims 1-29 for at least the Reason that These References Fail to Teach or Suggest Recording an Access Authorization in the Client Computer System</u>

Independent claims 1, 10, and 21 all include the feature of recording an authorization for access to data <u>in the same computer system</u> in which the data is stored. In contrast, Wyman teaches recording authorizations for access to data in a <u>remote</u> license server system. In addressing this issue, the Office Action states "with regard to the newly added limitations of recording of recording authorizations within the user computer system, Wyman in column 23, lines 11-37 discloses storing the authorization handle on the client computer for future reference." As acknowledged by the Examiner during the November 7 telephone interview, however, the "grant handle" disclosed by Wyman <u>is not</u> authorization to grant access to data as recited in the present claims. As Wyman explains, the grant handle merely identifies the allocation grant created by a previous call to request allocation of a license. By using a handle, a subsequent request for access that is sent to the server is expedited because the handle identifies the allocation granted during a previous call. (See column 22, lines 14-36 of Wyman.)

Even though the handle *may* be stored on the client computer system for later reference, the handle is not authorization for access to a software product. Wyman makes this clear in column 23 at lines 38-68. This text refers to Figure 6 of Wyman which is a flow chart describing actions of the server 10. As this text explains, if a

release allocation call is received from a user computer system, then the grant handle in the argument of the release allocation call is checked for validity. "If the handle is valid, the authorization for this product is retrieved from the [server] database 23 at block 83, and updated as indicated by block 84." (Emphasis and word in brackets added.) Thus, this portion of text from Wyman confirms that the grant handle stored on the client computer system merely identifies the grant sought, but does not equate to authorization for access to the desired product.

During the telephone interview between the Examiner and the undersigned attorney on November 7, the Examiner acknowledged that the grant handle taught by Wyman does not provide the basis for a properly framed Section 103 rejection of the pending claims. At this juncture, however, the Examiner suggested that Col. 4, lines 27-50, were pertinent to aspects of the pending claims. This text in the Background section of Wyman appears to discuss a client/server licensing method for authorizing access to server/client applications. The method requires that each client be individually licensed if use of a particular server is desired. Such a licensing scheme apparently makes it possible to charge customers only for the specific number of client licenses they purchase. Wyman states, however, that such a "transitive licensing" scheme may be undesirable, and goes on to suggest "the solution to this transitive licensing problem would be to provide a mechanism that would allow the clients to obtain license unit allocations and then pass a "proof" of that allocation to any servers they may wish to use." Nowhere, however, does Wyman provide any details as to how such "a mechanism" would work. Accordingly, this vague reference to "a mechanism" in the Background of Wyman cannot reasonably be construed to teach the features of the pending claims that are lacking from the rest of Wyman. As a result, Wyman fails to teach or suggest all of the features of base claims 1, 10, and 21 -- point the Examiner acknowledged during the November 7 telephone interview with the undersigned attorney.

Furthermore, applicant's own admission fails to cure the deficiencies of Wyman with respect to base claims 1, 10, and 21. The only admission by the applicant applied in the Office Action is a reference to AOL (America On-Line). The Office Action only

relies on this reference to provide the features of dependent claims 4-9 and 12, and not the features of base claims 1, 10 and 21. Therefore, the applied references of Wyman and applicant's own admission cannot support a proper Section 103 rejection of base claims 1, 10, and 21 for at least the reasons that these references fail to teach or suggest all the claimed features. Accordingly, the rejection of base claims 1, 10, and 21 should be withdrawn.

Claims 2-9 depend from base claim 1. Claims 11-20 depend from base claim 10. Claims 22-29 depend from base claim 21. Accordingly, Wyman and applicant's own admission cannot support a Section 103 rejection of dependent claims 2-9, 11-20, and 22-29 for at least the reasons discussed above with regard to the Section 103 rejection of the corresponding base claims, and for the additional features of these dependent claims. Accordingly, the rejection of dependent claims 2-9, 11-20, and 22-29 should be withdrawn.

VI. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. Therefore, a Notice of Allowance is respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned attorney at (206) 359-6351.

Respectfully submitted,

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